

Attorney Docket No. 15737US01

REMARKS

The present application includes claims 106-107 and new dependent claims 108-122.

Prosecution History

In an effort to expedite allowance, Applicant had previously offered to minimize the number of claims from one hundred five claims to two claims, claims 106 and 107 (drafted along the lines of original claims 61-80), if the Examiner would agree, at the interview of October 13, 2004, as to their allowability in view of four prior art references discussed at the interview. Applicant believes that an agreement was reached that claims 106, 107 were allowable, contingent on a final search by the Examiner to identify additional prior art, if any, before allowing the claims. Applicant reported this to the Examiner by a written Amendment one (1) day after the interview (Amendment filed October 14, 2004) and again six (6) days after the interview in a subsequent paper (37 CFR 1.133 Statement filed October 19, 2004). However, three months after the interview, the Examiner issued an Office Action dated January 13, 2005, in which she disagreed with the report.

Applicant then scheduled a second interview. That second interview occurred on March 8, 2005. The prior art was discussed in relation to the claims, as well as the Section 112 rejection. However, no agreement was reached at this second interview.

A co-pending continuation application Serial No. 10/990,129, filed November 16, 2004, presently exists with claims broader in some respects than present claims 106-122. In addition, a second co-pending continuation application has been filed and which involves a Petition To Make Special. Because it is believed that prosecution of the

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present application is nearing completion, a similar Petition To Make Special has not been filed in the present case despite grounds to do so.

The Present Amendment

In an effort to move the application to allowance, applicant has amended claims 106, 107 and added dependent claims 108-122, with an eye to the language of original claims 61-80.

In particular, original claims 61-80 (pages 18-20 of the specification) are directed to a method of awarding a random prize, and more particularly, awarding a random progressive jackpot (claims 78-80) and awarding the prize from a plurality of prizes of unequal value (claim 77). A main game is played during which a trigger condition is determined (Claim 63). The trigger condition initiates a feature game (Claim 63). The trigger condition is determined using a predetermined range of random numbers and a set of allotted numbers, the size of the set of allotted numbers being related to the amount of the wager which is bet (Claims 65 and 70).

35 USC 112, 1st paragraph

Claims 106-107 presently stand rejected under 35 UCS 112, first paragraph. The Examiner contends that the specification does not disclose allotting a plurality of numbers for each credit bet. Although the Applicant respectfully disagrees with the Examiner (see for example, page 4, lines 7-8, "for each credit bet on the respective game, allotting to the game one or more numbers..."), the Applicant has deleted the language from claim 106 and has used instead in claim 107 the language: "allotting to the player a plurality of numbers . . . in proportion to the amount of the wager made" (see, application, Figure 2, block 23 "allot numbers to game in proportion to the credits bet";

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also, page 5, lines 1-5 “the numbers allocated will be proportional to his total wager”). It is respectfully submitted that claims 106 and 107 meet the requirements of 35 USC 112, first paragraph.

35 USC 103

The Applicant now turns to the Examiner’s rejection of claims 106-107 under 35 U.S.C. 103 as unpatentable over Torango (U.S. Patent No. 6,592,460). Torango discloses a system for accepting wagers in different currencies (e.g., Canadian dollars, U.S. dollars and pesos) and allowing players in different geographic locations to play for a common progressive prize (Torango, Abstract; Figure 1). The Torango system also dynamically adjusts the odds of a gaming machine in awarding a progressive prize to accommodate for changing currency exchange rates (Torango, col. 3, line 63 - col. 4, line 4; col. 13, lines 21-50). In addition, Torango discloses retrofitting a gaming machine with a “Free Play apparatus.” This Free Play apparatus serves to simulate progressive play line logic in “gaming devices devoid of progressive game play [sic] line logic.” (Torango, col.1, lines 20 – 23).

Claim 106

Claim 106 recites a method of awarding one of a plurality of progressive prizes. A first main game is played, and upon a trigger condition, a second game is displayed to the player. The player activates a user interface to affect the display of the second game, in order for the player to participate in the second game display. The outcome of the second game determines which one of the prizes is won. The second game is triggered in response to a trigger condition which occurs upon an event having a probability of occurrence dependent on the amount of the wager.

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(a) First reason Torango does not make Claim 106 obvious: Second game determines which prize has been won

Claim 106 recites “the outcome of said second game determining which one of said plurality of progressive prizes has been won.” (See description at page 10 of present application). The cited Torango patent does not disclose the play of both a first main game and a second game in which the outcome of the second game determines which one of several progressive prizes has been won. In Torango, the prize may be identified in advance by the player (Torango, Figure 7, block 703), but which prize is won is not determined by the outcome of a second game (Torango, col. 15, line 66 – col. 16, line 7). Torango purposely sets the odds of the outcome based on the “characteristics” of the progressive prize itself. In Torango, the odds are computed based on the “Total Wager Amount” which will vary from prize to prize (Torango, col. 8, lines 9-15, where Total Wager Amount is a value which supports criteria, e.g., the prize starting value). (See also Torango, col. 16, lines 11-30, where Total Wager Amount - PT - is used to compute odds). Since the odds must be known in advance of the outcome, the progressive prize (which identifies the total wager amount upon which the odds are based) must be known in advance of the outcome. It is for this very reason that it would not have been obvious in view of Torango for the outcome of a second game to determine which progressive prize has been won. The Torango prize must be identified in advance of odds computation in order to use the identified prize’s Total Wager Amount in the odds computation.

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(b) Second reason Torango does not make Claim 106 obvious: Second game displayed and display affected by player activating the user interface

In addition to second game determination of which prize has been won, claim 106 recites the steps of “triggering” and “displaying” a second game, and “activating” the user interface during the display of the second game to affect the display of the second game. Torango does not teach a second game which is triggered to appear upon a trigger condition, let alone activating a player interface, for example activating buttons, to affect the display of the second game. Torango’s Free Play apparatus is used to simulate a progressive pay line (“Creating a linkage between a gaming device with no progressive pay lines and a progressive prize requires that the Free Play apparatus be attached to the gaming device to contain the logic for generation of random numbers to simulate the play of the progressive pay line.” (Emphasis added, Torango, col. 14, lines 60-64). Torango merely provides the awarding of a progressive prize by retrofitting a non-progressive gaming machine with a Free Play apparatus having a random number generator (Torango, col. 15, lines 5-9). In Torango, there is no triggering of a second game to appear at the gaming machine. There is no displaying of a second game. There is no activating of a player interface to affect the display of the second game. Torango’s Free Play apparatus simply allows a specific progressive prize to be won by a gaming device with no progressive pay line logic.

Nor would it have been obvious to display a second game in Torango, since Torango merely seeks to make a non-progressive gaming machine (having one game displayed) a progressive gaming machine. Nor can it be said that it would be obvious in view of Torango to provide a user interface and to activate the interface by the player

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during display of the second game to affect the second game display, since Torango is merely retrofitting a non-progressive gaming machine to have progressive game pay line logic.

(c) Third reason Torango does not make claim 106 obvious: Second game triggered dependent upon the amount of the wager.

Claim 106 recites “triggering a second feature game to appear . . . in response to said trigger condition” and “said trigger condition occurring upon an event having a probability of occurrence dependent on the amount of the wager” Torango’s Free Play apparatus is started by a handle pull and is not triggered upon the occurrence of an event having a probability dependent upon the amount of the wager, as defined by claim 106. Torango’s Free Play apparatus is not “triggered” by anything other than a handle pull (col. 16, lines 8-11; col. 15, lines 44-46; Figure 7, blocks 704, 705), and certainly not triggered upon an event having a probability of occurrence dependent on the amount of the wager.

For this reason as well, it cannot be said that Claim 106 is obvious in view of Torango. There is no suggestion to “trigger” Torango’s Free Play Apparatus in response to an event having a probability of occurrence related to the amount of the wager. The entire purpose of Torango’s Free Play apparatus is to simulate a progressive pay line logic every time the handle is pulled (with the required bet if any is required).

Claim 107

Claim 107 further defines the step of “determining the trigger condition”. The step includes “allotting a plurality of numbers . . . in proportion to the amount of the wager made.” These numbers are allotted from a predetermined range of numbers. If

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one of the allotted numbers matches the selected random number, the occurrence of the trigger condition is indicated.

In contrast, Torango's Free Play apparatus simulates a progressive pay line logic, in which a random number is generated and compared to only one number, and it is a predefined number, the number "1" (Torango, col. 16, lines 43-45). This may be similar to other pay lines where random numbers are generated and compared to numbers corresponding to AAA, BBB, CCC, etc. (See, Torango, Figure 15 with odds shown). As the Examiner points out in her Action, Torango does not disclose allotting a plurality of numbers.

Nor, would it have been obvious in view of Torango to allot a plurality of numbers in proportion to the amount of the wager made, for comparison with the generated random number. Torango discloses computing the range of numbers for the random number generator. The maximum number of that range ("MR") is computed based on total wager amount (Torango, col. 16, lines 8-14) which is represented in different currencies, (Torango, col. 3, lines 59- col. 4, line 4; col. 13, lines 21-50). To add more numbers in Torango (against which the random number is compared) would affect the "odds" which have been purposely and previously defined before the random number is generated. This is counter productive since Torango purposely computes the odds based on currency exchange rates. That is, to allot a plurality of numbers interferes with the odds computation by the addition of another factor, and an unnecessary factor. It is not obvious to add an interfering factor to Torango's range computation. In addition, the interfering factor is a variable, which is unknown until the wager is placed. To add still another variable to the odds computation would cause additional complexity, a

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direction leading away from the Torango subject matter. There is no reason or basis to do so. That is, it would not have been obvious in view of Torango to allot a plurality of numbers to compare against a random number selected from a range of numbers which is changing, and which is purposely computed, where the allotment of plural numbers affects the purposely computed range of numbers.

The law is well settled that "obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montfiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to simply pick and choose among the individual elements of assorted prior art references to recreate the claimed invention, but rather "some teaching or suggestion in the references to support their use in the particular claimed invention" is needed. Symbol Technologies, Inc. V. Opticon, Inc., 935 F.2d 1569, 1576, 19 USPQ 2d 1241 (Fed. Cir. 1991). The Board of Patent Appeals and Interferences has noted that "citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention." Ex parte Hiyamazi, 10 USPQ 2d 1393 (Bd. Pat. App. & Interf. 1998) ; see also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Claim 109

Claim 109 is dependent on claim 107 and adds further limitations that the allotting of numbers is based on credits bet. Torango's computation system is based on

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currency value of the wager in a selected currency. For example, a one credit bet on a quarter machine (i.e., 25¢) in Torango's system, must generate the same odds as a five credit bet on a nickel machine (25¢) in Torango's system. However, in claim 109, one (1) number would be allotted for the quarter machine and five (5) numbers would be allotted for the nickel machine, for example, even though the same 25¢ bet had been played on both machines. Again, Torango's computation is performed using the value of the wager in the selected currency to ensure that the odds of winning the progressive prize are the same for the quarter machine and for the nickel machine.

Claim 111

Claim 111 defines the initialization of the random number generator at start up (application, page 7, lines 22 – 25) and prior to playing said first main game (application, flow chart in Figure 2, blocks 20, 21). For every game that is played (application, page 7, line 26), a random number from the predetermined range is selected.

Claim 111 would not have been obvious to one of ordinary skill in the art in light of Torango. First, the predetermined, fixed range of numbers is neither taught nor suggested by Torango's Free Play apparatus. In Torango, the range of numbers is computed on every play, and the range of numbers is intended to change as Total Wager Amount changes with currency exchange rate fluctuations. In Torango, "[p]lay is executed by determining the value of the wager, then creating a set of numbers for the random number generator..." (col. 16, lines 11-13). The range of numbers is not predetermined and is not fixed. Also, Torango does not, for every game that is played, select a number from the fixed predetermined range of numbers. In Torango, the range of numbers is purposefully not fixed and is not predetermined so that currency

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fluctuations adjust the range of the random number generator to equalize the odds between different currencies. If the range of numbers in Torango were fixed, then the variable "MR" would become a constant in the range/odds equation (col. 16, lines 16-18). However, the purpose of Torango is to allow fluctuation in currency exchange rates to adjust the odds of the gaming machine. Thus, the Total Wager Amount (PT in the equation at col. 16, lines 16-18) must change.

Thus, it would not have been obvious in view of Torango to have a predetermined, fixed range of numbers for the random number generator from which on every play, a number is selected.

Claim 113

Claim 113 recites that the second game appears at the completion of said main game. In Torango, there is no second game that appears at the completion of the main game. Torango has a base game with several prizes which may be retrofitted to provide winning of a progressive prize.

Claim 115

Claim 115 recites that the second game is displayed as spinning reel strips in which the reel strips are stopped. Clearly, such a second game is not described in Torango.

Claim 116

Claim 116 further defines the user interface to include buttons, and the step of stopping the spinning reel strips in the second game is performed by pressing the buttons.

Claim 117

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Claim 117 recites the step of triggering to include awarding more than one game (application, page 12, lines 15, 16). Torango does not disclose a third game or more games. It would not have been obvious in view of Torango to add two or even more than two games to a triggering step. There is simply no suggestion to do so.

Claim 121

Claim 121 claims that the second game has a higher probability of success than the first main game.

Claims 108, 110, 112, 114, 118, 119, 120 and 122

Claims 108, 110, 112, 114, 118, 119, 120 and 122 (as well as the other dependent claims discussed above) are ultimately dependent on claim 106, and add further limitations. Thus, Claims 107 through 122 are allowable for the same reasons given above as to the non-applicability of Torango to Claim 106.

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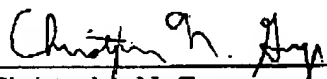
CONCLUSION

It is submitted that the present application is in condition for allowance and a Notice of Allowability is respectfully solicited. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any additional fees or credit overpayment to the Deposit Account of MHM, Account No. 13-0017.

Respectfully submitted,

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